

REMARKS

By entry of this amendment, claims 1, 3-6, 46-58 and 60-67 are pending in this application. Claims 1, 3-6, 46-58 and 60-65 have been rejected. Claims 1, 46, 49, 53, 57, 61, 63 and 65 have been amended, and claims 66 and 67 are new. Support for the claim amendments can be found at least at paragraphs [0022] and [0027] of Applicants' published patent application. In view of foregoing amendments and following remarks, the applicants request allowance of the application.

Substance of Examiner Interview

The Examiners are thanked for the time spent discussing the independent claims and the applied prior art during the March 10, 2009 Examiner Interview. In particular, the Shankar patent was discussed with respect to independent claims 49 and 53. The remaining independent claims were discussed with respect to the Berry patent. No agreement was reached. The foregoing amendments and following remarks include substantially the substance of the interview, and Applicants submit that no further submissions are required.

Claim Rejections under 35 U.S.C. §102

Claims 49-53 and 55 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Shankar et al. (U.S. Patent No. 6,570,869). Applicants respectfully disagree.

Claim 49 recites, in part:

determining whether the calling telephone and the called telephone support compatible voice compression algorithms;
if the calling telephone and the called telephone use incompatible voice compression algorithms, maintaining the call from the calling telephone to the called telephone on the circuit switched network; and
if the called telephone supports a voice compression algorithm that is compatible with a voice compression algorithm supported by the calling telephone, (a) diverting the call from the circuit switched network to a data network; and
(b) exchanging voice signals, over the data network, compressed at either the calling telephone or the called telephone, wherein the compression of the voice signals is performed using the compatible voice compression algorithm.

Shankar does not disclose determining whether the calling telephone and the called telephone support compatible voice compression algorithms or maintaining the call on the circuit switched network, or diverting the call if the called telephone supports a voice compression algorithm, or

exchanging voice signals compressed at either the calling telephone or the called telephone as recited in claim 49. Independent claim 53 recites similar language as claim 49.

As illustrated in FIG. 1 of Shankar, the call set up is performed by the originating coding unit 110 and the terminating coding unit 150. However, neither the originating coding unit 110 nor the terminating coding unit 150 of Shankar are calling telephones and called telephones as recited in the claims. As described at column 4, lines 20-30 of Shankar, the originating coding unit is some form of switch that functions as a gateway and is coupled to originating node 100. The terminating coding unit 150 is similarly described at column 4, lines 55-65 of Shankar.

Furthermore, as described at column 5, lines 53-63 of Shankar, once a call is set up on a legacy system, the call is transferred to the packet-switched network 130. Shankar transfers all calls to the packet-switched network 130 regardless of the whether the calling telephone and the called telephone have incompatible voice compression algorithms. Shankar does not disclose maintaining a call on the circuit switched network as recited in claims 49 and 53.

Shankar does not disclose or even suggest a telephone, whether the calling or the called, that can perform compression. Accordingly, Shankar does not anticipate claims 49 and 53. Claims 50-52 and 55 depend from claims 49 and 53, respectively, and are also not anticipated by Shankar.

Claim Rejections under 35 U.S.C. §103

Claims 1, 3, 5-6, 46-48, 54 and 56-64

Claims 1, 3, 5-6, 46-48, 54 and 56-64 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Shankar et al. in view of Berry et al. (U.S. Patent No. 5,758,256). Applicants respectfully disagree.

In making the rejection of independent claim 1, the Office asserts that Shankar discloses all of the claimed features except for the determining step that is accomplished by exchanging messages between said called party's audio device and said calling party's audio device via a circuit switched network. The Office relies on Berry to disclose the circuit switched network, which the Office equates to the PSTN 26 disclosed in FIG. of Berry.

However, claim 1 recites, in part:

determining whether **a called party's audio device** is able to support at least one voice compression algorithm supported by **a calling party's audio device based on messages sent between said called party's audio device and said calling party's audio device** via a circuit switched network;
if said called party's audio device is able to support said at least one voice compression algorithm, (a) **compressing said voice signals, at the calling party's audio device**, using at least one voice compression algorithm determined to be supported by both said called party's audio device and said calling party's audio device over a data network;
(b) sending said compressed voice signals to said called party's audio device **from said calling party's audio device** via said data network; and
(c) **decompressing said compressed voice signals using said supported voice compression algorithm at said called party's audio device;**

Neither Shankar nor Berry discloses voice signals that are compressed by the calling party's audio device and the called party's audio device as recited in claim 1.

Berry discloses that compression of the voice signals is performed at the fixed subscriber unit (FSU) (see, column 1, lines 12-15 of Berry). As shown in FIG. 1 of Berry, the compressed voice packets sent over signal path 50 originate from the fixed subscriber unit (FSU) 10, not the origination devices 5. As presented during the telephone interview, the origination devices 5, which may be analogous to the claimed audio device, do not support voice compress as do the claimed audio devices. Shankar does not determine the voice compression algorithms supported by the calling or called audio devices, and neither does Berry.

Claim 1 now also incorporates the features of dependent claim 4 that was rejected under the combination of Shankar, Berry and Wilson.

As explained above, Shankar and Berry do not disclose or suggest claimed determining step as recited in claim 1. In making the rejection of claim 4, the Office asserts Wilson for its alleged disclosure of allowing users to receive and transmit compressed Internet voice messages. Putting aside whether Wilson may disclose exchanging compressed voice signals between computers connected to the Internet, Wilson does not disclose the claimed determining step as recited in claim 1. For example, Wilson does not determine whether a called party's audio device is able to support at least one voice compression algorithm supported by a calling party's audio device as recited in claim 1. In Wilson, the user must either press Internet or the Plain Old Telephone System as described at column 4, lines 8-12 of Wilson, there is no consideration for the capabilities of the receiving device as in Applicant's

claims. Accordingly, Wilson does not overcome the deficiencies of Shankar and Berry. Shankar and Berry, individually and in combination, do not disclose or suggest the features of claim 1. Accordingly, claim 1 is allowable over the combination of applied prior art. Claims 3-6 depend from claim 1, and are also allowable.

Furthermore, the combination of Shankar, Berry and Wilson is improper. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Applicants respectfully submit that the modification of combination of Shankar, Berry with Wilson would destroy the principle of operation of either Shankar or Berry, or both. Neither suggests being useable with a device as suggested by Wilson. In more detail, both Shankar and Berry compress data at a switch, in other words, once the uncompressed data is passed from the originating device. When combined with the system of Wilson, Shankar and Berry would continue to monitor the capabilities of the destination switch. If the destination switch was incapable of receiving compressed data, the systems of Shankar and Berry would merely forward the compressed data provided by Wilson over the communication channels to the destination switch. This result is contrary to the claimed invention. By suggesting that the compression of the signals would be performed at the device of Wilson instead of at the switches of Shankar and Berry, the combination destroys the principle of operation of at least Shankar or Berry, or both because there would be no need for Shankar and/or Berry to determine whether the receiving switches were capable of decompressing compressed voice signals since Wilson would have already compressed the signals. In other words, compressed voice signals are being transmitted regardless of the determination of the capabilities of the receiving switches made by Shankar or Berry. Accordingly, the combination of Shankar, Berry and Wilson is improper, and any rejection of newly amended claim 1 would be improper. Claim 1 is allowable.

In making the rejection of independent claim 46, the Office asserts that Shankar discloses all of the claimed features, except for setting up the voice call over the communication network if the called digital wireless telephone and the calling digital wireless telephone use incompatible voice compression algorithms. Again, the Office relies on Berry to disclose the feature not disclosed by Shankar. The Office relies on column 6, lines 10-14 and 30-32 of Berry

to disclose the missing features. However, as presented above with respect to claims 1, 49 and 53, Berry does not overcome the deficiencies of Shankar.

Independent claim 46 recites, in part:

determining, prior to completing the call setup between the calling digital wireless telephone and a called digital wireless telephone, ***whether the called wireless digital telephone uses a voice compression algorithm that is compatible with a voice compression algorithm used by the calling digital wireless telephone;***

(b) ***exchanging compressed voice signals between the calling digital wireless telephone and the called digital wireless telephone*** during the voice call over the Internet, ***wherein the voice signals are compressed using the compatible voice compression algorithm at either the calling digital wireless telephone or the called digital wireless telephone***

As discussed above, neither Shankar nor Berry disclose or suggest determining the voice compression algorithms supported by either the calling digital wireless telephone or the called digital wireless telephone, or a digital wireless telephone that compresses or decompresses voice signals as recited in claim 46. The citations to column 6 of Berry refer to the fixed subscriber unit (FSU) 10 performing the compression, not the origination devices 5. Claim 46 is allowable over the combination of applied prior art. Claims 47 and 48 depend from claim 46, and are also allowable.

In making the rejection of independent claim 57, the Office asserts that Shankar discloses all of the claimed features, but admits that Shankar does not disclose a circuit switched network. The Office relies on Berry to disclose the feature missing from Shankar.

However, claim 57 now recites, in part:

consulting information relating to compatibility of respective ***voice compression*** algorithms ***supported by the calling party's telephone*** and the ***called party's telephone***, wherein ***the information is included in a request issued by the calling party's telephone and in a response to the request from the called party's telephone***

Neither Shankar nor Berry disclose a request including information related to the compatibility of voice compression algorithms supported by specific telephones and the information included in a request issued by the calling party's telephone. At best, Berry discloses that the fixed subscriber unit 10, which connects origination units 5 to the cellular base transceiver system (BTS) 12, (see, column 4, lines 44-51, in particular lines 48-51, and column 6, lines 9-13 of

Berry) is the device that must have compatible voice compression algorithms, not the calling or called telephones as recited in claim 57. Claim 57 is allowable over the combination of applied prior art. Claims 58 and 60 depend from claim 57, and are also allowable.

In making the rejection of independent claim 61, the Office asserts that Shankar discloses all of the claimed features, but admits that Shankar does not disclose digital wireless telephones, a public switched telephone network, and if the response message indicates that the called digital wireless telephone cannot support one of the voice compression algorithms on the list or that the called digital wireless telephone cannot access the data network, completing the call setup procedure via the public switched telephone network. Again the Office relies on Berry at column 6, lines 10-14 and 30-32 to disclose this feature.

Claim 61 now recites, in part:

if the response message indicates that the called digital wireless telephone can support one of the voice compression algorithms on the list and that the called digital wireless telephone can access the data network, completing the call setup procedure via the data network and ***sending data compressed according to the listed voice compression algorithm from the calling digital wireless telephone to the called digital wireless telephone***

As explained above with respect to claim 46, neither Shankar nor Berry, either individually or in combination, disclose or suggest sending data compressed according to the listed voice compression algorithm from the calling digital wireless telephone to the called digital wireless telephone. Accordingly, claim 61 is allowable over the combination of applied prior art. Claim 62 depends from claim 61, and is also allowable.

In making the rejection of independent claim 63, the Office asserts that Shankar discloses all of the claimed features, but admits that Shankar does not disclose an MSC couple to a PSTN, digital wireless telephone, sending a call request message received from a calling digital wireless telephone at the MSC, and if the called digital wireless telephone does not support one of the voice compression algorithms on the list or does not have access to the data network, completing the call setup procedure via the PSTN. The Office relies on Berry's disclosure at column 2, lines 65-67 to overcome the admitted deficiency of Shankar.

However, claim 63 now recites, in part:

exchanging ***compressed voice signals*** between ***the calling digital wireless telephone*** and ***the called digital wireless telephone***, wherein the voice

signals are ***compressed*** according the supported voice compression algorithm ***by either the calling digital telephone and the called digital telephone***

As explained above with respect to claim 46, neither Shankar nor Berry, either individually or in combination, disclose or suggest compressed voice signals that are exchanged between the calling digital wireless telephone and the called digital wireless telephone, or voice signals compressed according to one of the supported voice compression algorithms by the calling digital telephone and by the called digital telephone. Neither Shankar or Berry compress voice signals at a digital wireless telephone. Accordingly, claim 63 is allowable over the combination of applied prior art. Claim 64 depends from claim 63, and is also allowable.

Claim 65

Claim 65 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Shankar et al. in view of Farris (U.S. Patent No. 6,064,653). Applicants respectfully disagree.

The Office relies on Farris to disclose the setting up of calls on the ISUP as recited in the claim.

However, claim 65 now recites, in part:

determining, using an ISUP signaling path, whether a called party's telephone is configured to exchange voice signals via a same data network to which a calling party's telephone is adapted to exchange voice signals ***using a voice compression algorithm compatible with both the calling party's telephone and the called party's telephone***, said ISUP signaling path being established during a process of establishing the ISUP network talkpath; establishing the data network talkpath using resources associated with said same data network if said ***called party's telephone is configured to exchange compressed voice signals between said calling party's telephone and said called party's telephone via said same data network using the compatible voice compression algorithm***;

As explained above with respect to claims 46 and 63, Shankar does not disclose or suggest a calling party's telephone that compresses voice signals or a called party's telephone that decompresses the compressed voice signals as recited in claim 65.

Farris is directed to an internet gateway to gateway alternate communication. Farris does not overcome, and is not asserted to overcome the above deficiencies of Shankar. Accordingly, claim 65 is allowable over the combination of Shankar and Farris.

Claim 4

Claim 4 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Shankar and Berry et al. further in view of Wilson (U.S. Patent No. 6,169,734). Claim 4 has been canceled. The rejection is moot.

Conclusion

All outstanding rejections have been overcome. It is respectfully submitted that, in view of the foregoing amendments and remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

Although not believed necessary, the Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Office is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

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